

Application No.: 10/829,097
Reply to Office Action of October 17, 2005
Amendment Dated January 5, 2006

Remarks:

Status of Claims

Claims 1-20 were previously pending, claims 1 and 13 are currently amended, and claim 3 is canceled by way of this Amendment. Thus, claims 1-2 and 4-20 are currently pending with claims 1, 13, and 20 being independent.

Office Action

In the October 17, 2005, Office Action the Examiner objected to Applicant's declaration, rejected claims 1, 3, 4, and 8-12 under 35 USC 103(a) as being unpatentable over Meyer (U.S. Patent No. 4,237,454) in view of Schuermann (U.S. Patent No. 5,053,774), rejected claims 2, 5-8, and 13-19 under 35 USC 103(a) as being unptanteable over Meyer and Schuermann in further view of Newman (U.S. Patent No. 6,728,638), rejected claims 1-4, 11, 12, 15, and 16 based upon obvious-type double patenting over claims 1-20 of U.S. Patent No. 6,842,971, and rejected claims 5-8, 13, 14, and 17-10 based upon obvious-type double patenting over claims 1-20 of U.S. Patent No. 6,842,971 in view of Newman and Meyer. Applicant respectfully submits that the arguments made herein overcome the Examiner's rejections as no prior art of record discloses or suggests all currently claimed features of the present invention.

Oath or Declaration

The Examiner objected to Applicant's declaration for failing to identify the inventor's residence. As is indicated by the USPTO PAIR system, Applicant submitted a supplemental Declaration including the inventor's residence on August 2, 2005. In view of the August 2, 2005, submission, Applicant respectfully requests that the Examiner withdraw his objection to the Declaration.

Double Patenting Rejections

Submitted herewith is a Terminal Disclaimer which overcomes the Examiner's non-statutory

obviousness-type double patenting rejections based upon commonly-owned U.S. Patent No. 6,842,971.

Rejections Based on Meyer, Schuermann, and Newman

Claims 1 and 13 have been amended herein to include the feature of a base unit which “substantially continuously” powers a transmitter over a wireless connection. Claim 20 included this feature as originally filed. By “substantially continuously” powering the transmitter over the wireless connection, the present invention enables the transmitter to indicate the status of the detector at any time. For instance, should the detector be actuated or otherwise detect a condition, the transmitter is operable to immediately transmit a status signal without waiting for an interrogation signal, or other power-providing signal, from a base unit.

The Examiner concedes that Meyer, Schuermann, Newman, and all other prior art of record, fail to disclose or suggest a transmitter which is substantially continuously powered by an external base unit (Office Action, page 3). However, the Examiner contends that it would be obvious to modify the combination of Meyer and Schuerman to continuously power a transmitter over a wireless connection “for the purpose of supplying power to the transmitter” (Office Action, page 3).

Applicant respectfully submits that the Examiner’s proposed suggestion and motivation to modify the combination of Meyers and Schuerman to conform to the present invention is insufficient to establish a requisite *prima facie* case of obviousness. The Examiner bears the burden of providing the suggestion of the desirability of doing what the inventor has done. *MPEP 2143.01*. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed.Cir.2001). In presenting the suggestion or motivation to combine, particular findings must be provided as broad and conclusory statements, standing alone, are not “evidence” of a suggestion or motivation. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Further, the suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the Office Action, the Examiner merely generated a broad and conclusory statement utilizing Applicant's own disclosure, namely that substantially continuous powering of a wireless transmitter is advantageous, as "evidence" of the obviousness of the present claimed invention. The Examiner failed to locate or identify any disclosure in Meyer or Schermann that would suggest substantially continuously powering a wireless transmitter. Thus the Examiner is utilizing impermissible hindsight based on Applicant's own disclosure and has failed to establish a prima facie case of obviousness.

Further, both Meyer and Schuermann teach away from continuous powering of a wireless transmitter such that there can be no suggestion or motivation to modify the combination as suggested by the Examiner (see MPEP 2143). For instance, Meyer provides no suggestion or motivation to include a wireless power supply as Meyer already includes a internal and integral piezoelectric-crystal which provides continuous power (col. 3, lines 45-56). Similarly, Schuermann's disclosure is limited to providing intermittent power to a wireless transmitter in response to an operator input (col 6, lines 63-69, col. 7, lines 13-15, and FIG. 3). Further, Schuermann discloses that repeated transmissions of interrogation pulses (which power the transmitter) are undesirable due to the existence of a return transmission cycle which may be violated by multiple pulses (col. 10, lines 48-54). As such, one skilled in the art would not be motivated to combine Schuermann (which discloses intermittent wireless powering only) with Meyer (which discloses a device having an integral and continuous power supply).

Further, as no prior art of record discloses or suggests substantially continuous powering of a wireless transmitter, and the Examiner does not contend that Schuermann inherently discloses such a feature, the Examiner is relying on "official notice" that the one skilled in the art would be motivated to modify Schuermann and Meyer to conform to the presently claimed invention. As recited in MPEP 2144.03, official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. It is not appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts

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asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. *MPEP 2144.03*. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

As the Examiner's conclusion that one skilled in the art would be motivated to modify Meyer and Schuermann to continuously power a wireless transmitter is unsupported by any documentation, references, or prior art, and the conclusion is not "capable of instant and unquestionable demonstration as being well-known" as the cited references teach away from such functionality, the Examiner has improperly utilized official notice to reject the claims of the present application. Thus, Applicant respectfully requests that the Examiner withdraw his rejections or produce authority for his conclusion that continuously powering a wireless transmitter is known in the art.

Conclusion

Applicant respectfully submits that claims 1-2 and 4-20 are now in allowable condition and requests a Notice of Allowance. In the event of further questions, the Examiner is urged to call the undersigned. Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 19-0522.

Respectfully submitted,

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